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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,864	09/22/2003	James J. Kowalczyk	2003946-0057 (HEAT/CIP)	1361
24280	7590	02/10/2005	EXAMINER	
Choate, Hall & Stewart Exchange Place 53 State Street Boston, MA 02109			DESAI, RITA J	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/667,864

**Applicant(s)**

KOWALCZYK ET AL.

**Examiner**

Rita J. Desai

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 56-79 is/are pending in the application.
- 4a) Of the above claim(s) 62,78 and 79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 56-61,63-77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>2/2/05</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/29/03</u> . | 6) <input type="checkbox"/> Other: ____.   |

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### DETAILED ACTION

Claims 1-55 are cancelled.

New Claims 56-79 drawn to intermediates are added.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 56-61, 63-77 in part drawn to compounds which are intermediates wherein RG1, R2, RM2, RM1, R6, RX1, RX2 , are all H or aliphatic or aryl, L is CCRL1RL2 and g is 2 , classified in class 546 and various subclasses.
- II. Claims 56-61, 63-79 in part drawn to compounds and intermediates wherein RG1, R2, RM2, RM1, R6, RX1, RX2 , L and g are other than those given in group I , classified in class 546, 544, 548 and various subclasses. A further election of a single disclosed species is required. May be subject to further restriction.
- III. Claims 62-79 in part drawn to compounds which are intermediates as given in claim 62 , classified in various classes and subclasses. A further election of a single disclosed species is required. May be subject to further restriction.
- IV. Claims 56-79 in part , drawn to groups other than in Groups I-III, classified in various classes and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have a different core , bonding and different effects. The presence of all the various hetero groups with different hetero atoms gives the compound different properties and effects and geometric arrangements.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III or IV, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Nadege Lagneau on 2/2/05 a provisional election was made with traverse to prosecute the invention of Group I , claims 56-61, 63-77 in part drawn to compounds which are intermediates wherein RG1, R2, RM2, RM1, R6, RX1, RX2 , are all H or aliphatic or aryl, L is CCRL1RL2 and g is 2 , classified in class 546 and various subclasses.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 62, 78, 79 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

If applicant 's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups

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to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Applicants preserve their right to file a divisional on the cancelled non-elected subject matter without prejudice in due course.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

The claims are allowable over the prior art.

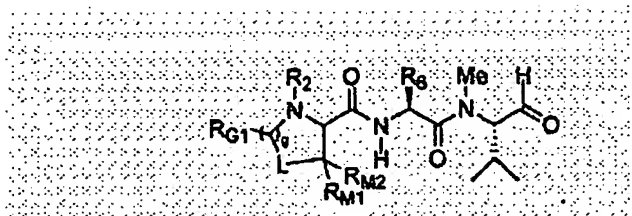
If applicants amend the claims to the elected group, the claims may be allowable.

Closest Prior Art:-

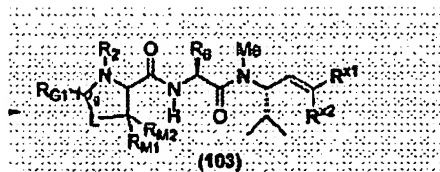
Steiner et al US 5798355 is the closest.

Applicants claims are drawn to

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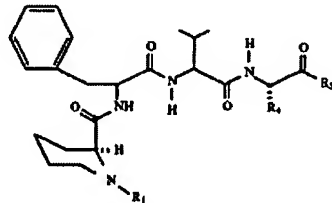
and



wherein RG1, R2, RM2, RM1, R6, RX1, RX2, are all H or

aliphatic or aryl, L is CCRL1RL2 and g is 2.

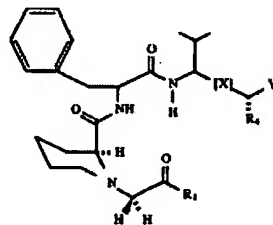
The prior art teaches compounds of the formula



wherein

R<sub>1</sub> = CH<sub>2</sub>(CO)-m-OCH<sub>3</sub>Ph (Compound 77)R<sub>4</sub> = CH<sub>2</sub>PhR<sub>3</sub> = OCH<sub>3</sub>

or

R<sub>1</sub> = CH<sub>2</sub>(CO)-B-naphthyl (Compound 78)R<sub>4</sub> = CH<sub>2</sub>PhR<sub>3</sub> = OCH<sub>3</sub>

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wherein  
 $R_1 = m\text{-OCH}_2\text{Ph}$  (Compound 79)  
 $X = \text{trans-CH=CH}$   
 $R_4 = \text{H}$   
 $Y = \text{OC(O)Ph}$   
 $R_1 = m\text{-OCH}_2\text{Ph}$  (Compound 80)  
 $X = \text{trans-CH=CH}$   
 $R_4 = \text{H}$   
 $Y = \text{OC(O)CF}_3$   
 $R_1 = m\text{-OCH}_2\text{Ph}$  (Compound 81)  
 $X = \text{trans-CH=CH}$   
 $R_4 = \text{—}$   
 $Y = \text{—}$   
 $R_1 = m\text{-OCH}_2\text{Ph}$  (Compound 82)  
 $X = \text{trans-CH=CH}$   
 $R_4 = \text{H}$   
 $Y = \text{OCH}_2\text{CH=CH}_2$   
 $R_1 = m\text{-OCH}_2\text{Ph}$  (Compound 83)  
 $X = \text{C=O}$   
 $R_4 = \text{H}$   
 $Y = \text{Ph}$

In column 58 of the patent.

X is a CH=CH R4 is a H and Y is Ph.

Applicants compounds have a N-CH3 instead of the NH as given in the prior art.

There is no motivation to change the secondary to a tertiary amine.

DE 10230874 , Alexander Domling et al teaches similar compounds but the date is not good.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rita J. Desai  
Primary Examiner  
Art Unit 1625

2/2/05

R.D.  
February 2, 2005